

REMARKS

Claims 1, 5-7, 28 and 31-32 are pending in the application. Claims 1, 7 and 28 are independent. Claims 1 and 7 have been amended herein.

Section 112 rejections

Claims 1 and 7 were rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement, and under 35 USC 112, second paragraph, as being indefinite. In light of the foregoing amendments to Claims 1 and 7, each of these rejections is believed to be overcome. Reconsideration and withdrawal of the Section 112 rejections are therefore respectfully requested.

Prior Art Rejections

Claims 1, 5-7, 28, 31 and 32 were rejected under 35 USC 103(a) as being unpatentable over newly-cited US Patent 6,448,979 (Schena) in view of US Patent 6,652,455 (Kocher). This rejection is respectfully traversed and reconsideration is requested.

Independent Claim 1 is directed to an apparatus for retrieving information related to a consumer product using a consumer product codes. The apparatus includes a portable consumer good that lacks the capacity for data transmission and a scanning and storage device incorporated into the portable consumer good. The scanning and storage device includes (i) a scanning element converting a product code symbol into machine readable information representative of the product code, and (ii) a removable memory medium to which the information is stored.

Independent Claim 7 also recites that the apparatus includes an Internet-ready device couplable to one or more Internet-based information servers, the Internet-ready device including a removable memory medium adapted to accept the removable memory medium from the scanning and storage device.

Independent Claim 28 is directed to a method for retrieving information related to a consumer product comprising the steps of integrating a bar code scanner and a removable memory into a consumer good that is a non-electronic device, scanning a bar code and storing the scanned bar code in the removable memory, transferring the scanned bar code from the removable memory to a computer network and accessing a web site based on the scanned bar code, wherein the web site includes information related to the selected consumer product.

The Action takes the position that Schena teaches all of the recited limitations of each of independent Claims 1, 7 and 28, but “does not specifically disclose and teach a removable memory” (the Action notes that Schena *does* however “disclose storing of the scanned bar code/data in an enhanced device such as key chain or smart card, in which the scanner is incorporated/integrated”). The Action then relies upon Kocher, stating that “in the same area of storing data in scanning device, [Kocher] teaches storing the data in a removable memory” – and that “one of ordinary skill in the art would have been motivated to extend the method and apparatus of Schena with a method and apparatus for storing the data in a removable memory of a scanner”.

Schena is directed to a device for “using scanner technology to bridge the gap between printed media and the virtual world of interactivity and the Internet” (col. 1, lines 52-54). Schena very specifically requires a device that “sends link information and the user input information via the network, *a receiver in communication with the scanner*, capable of receiving the link information and user input information...” (Abst). Schena does *not* teach or suggest, nor would one of ordinary skill in the art be motivated (in light of the teachings of Kocher at least), to modify Schena to include a removable memory device. In this regard, Schena specifically recites that “the scanner 100 generates and stores a code file in memory...uploads the coded file in memory 110 to the receiver 180” (col. 5, lines 37-39) – “scanner 100 can transmit the code 10 to a receiver 180, such as a television....or directly to the portal server 200” (col. 6, lines 27-31) – “communications bridge 130 sends the link information...to the receiver 180 and, via the network, to the portal server 200 (col. 7, lines 14-16) – “scanner 100 may access the portal server via a telephone dial system...a user may use a telephone to communicate the scanner 100 to the network” (col. 9, lines 30-33).

Kocher, relied upon for teaching a removable memory device, is directed to a device specifically designed “for scanning” – unlike Applicants’ claimed invention that recites a portable consumer good that *lacks the capacity for data transmission and comprises a non-electronic device* – and that has a scanning a storage device *incorporated therein*.

In addition, while Kocher does note that “product information is stored in databases on one or more removable memory modules 22” (col. 5, lines 26-29) – Kocher does *not teach or suggest* storing scanned information in a removable memory medium, *wherein the removable memory medium may be removed therefrom and inserted into an internet-ready device*.

Rather, while Kocher includes removable memory modules 22, he very specifically notes that the “while device and a remote computer *can be hardwired* in a conventional manner, such as transferring data by telephone lines, the invention also contemplates *using a wireless connection*” (Col. 5, lines 13-17). Kocher further notes that “an interface 20, such as a *serial or parallel port or infrared or other wireless transmitter*, is *used to exchange data* between this device and an external device, for the purpose of updating both databases or for transferring recorded data, personal data, and settings to a remote location” (Col. 6, lines 10-15).

There is absolutely no teaching or suggestion in either Schena (as acknowledged in the Action), *or Kocher*, of a removable memory medium in a portable consumer good that can be removed from the portable consumer good and inserted into an internet ready device.

Of course to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, *to modify the reference*. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed *modification* and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure*. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). 706.02(j) [emphasis supplied].

In addition to the arguments presented above, Applicants respectfully submit that it is, of course, improper to pick and choose elements from several references in order to “build” an obviousness rejection, when such a combination would not in fact have been obvious to one of ordinary skill in the art. Further, it is impermissible to use an Applicants’ specification as an

instruction manual or "road map" to piece together the teachings of the prior art in order to render claims obvious. The *only* suggestion for combining the alleged teachings of Schena and Kocher in the manner suggested is found in the luxury of the hindsight accorded one who first viewed Applicants' disclosure, which of course, is not a proper basis for a rejection.

Accordingly, Applicants respectfully submit that the Schena and Kocher references fail to meet this requirement of obviousness. Schena and Kocher do not teach or suggest, and one of ordinary skill in the art would not anticipate, in light of their teachings, a method or apparatus such as that recited by Applicant's independent Claims 1, 7 and 28.

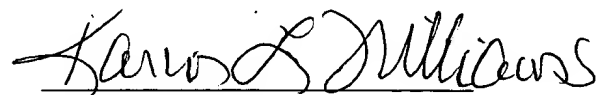
For all of the foregoing reasons, Applicants submit that independent Claims 1, 7 and 28 are patentable over Schena and Kocher and reconsideration is respectfully requested.

Claims 5-6 and 31-32 depend from independent Claim 1 or 28 and recite further limitations that even further distinguish over the art of record. It is respectfully submitted that remaining pending Claims 1, 5-7, 28 and 31-32 are patentable over any permissible combination of the teachings of Schena and Kocher.

Request for Telephonic Interview

Should the Examiner maintain the rejection based on Schena and Kocher, despite Applicants' discussion above, Applicants respectfully requests that the Examiner telephone Applicants' undersigned representative at (908) 518-7700 in order that any outstanding issues be resolved.

Respectfully submitted,



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